

REMARKS

After entering of this amendment, claims 1-21 will be pending. Claims 22-24 are withdrawn from consideration.

Claims 1-6, 9-15 and 17-19 have been amended. None of the amendments add new matter. Support for amended claims 1, 11, and 17 can be found throughout the specification, particularly, at page 3, lines 1-3; page 4, lines 20-23; page 19, lines 11-15; and page 32, lines 11-14. In addition, claims 1-6, 9-15 and 17-19 have been amended to improve their form.

Applicants respectfully request reconsideration in view of the following remarks. Issues raised by the Examiner will be addressed below in the order they appear in the Office Action.

Rejections under 35 U.S.C. §112, ¶1

The Examiner has rejected claims 1-21 as failing to comply with the written description requirement. The Examiner states that the specification discloses a single nucleic acid (SEQ ID NO:45) which encodes an NF-ATc polypeptide having the amino acid sequence of SEQ ID NO:46, but claims “a huge genus of polypeptides having functional activities distinct from the polypeptide of SEQ ID NO:46.” The Examiner states that “while at the time of filing applicants were in possession of NF-ATc polypeptides comprising SEQ ID NO:46, the limited information provided in the specification is not deemed sufficient to reasonably convey to one of skill in the art that Applicants were in possession of a representative number of the broadly claimed NF-ATc polypeptides and thus the written description requirement has not been satisfied for the claims as they are broadly written.” Applicants traverse the Examiner’s rejection.

However, in order to expedite prosecution, Applicants have amended claims the claims to recite the use of an NF-ATc polypeptide encoded by a nucleic acid that hybridizes under conditions of 5X SSC at 42 °C to SEQ ID NO:45, and has one or more specified biological properties. Applicants respectfully submit that the amended claims are adequately described in the specification.

Applicants wish to direct the Examiner’s attention to Example 9 of the “Revised Interim Written Description Guidelines Training Materials” obtained from the USPTO website. In Example 9 of the Guidelines, the specification discloses a single cDNA (SEQ ID NO:1) which encodes a protein having a specified biological activity. The claim is directed to a genus of nucleic acids, all of which must hybridize with SEQ ID NO: 1, and must encode a protein with a

specific activity. The Guidelines conclude that the claim is adequately described. The Guidelines state:

A person of skill in the art would not expect substantial variation among species encompassed within the scope of the claims because the highly stringent hybridization conditions set forth in the claim yield structurally similar DNAs. Thus, a representative number of species is disclosed, since highly stringent hybridization conditions in combination with the coding function of the DNA and the level of skill and knowledge in the art are adequate to determine that applicant was in possession of the claimed invention.

Based on the analysis presented in the Guidelines, Applicants respectfully submit that the claims of the instant application are adequately described. The claims require that the NF-ATc polypeptide be encoded by a nucleic acid that hybridizes under conditions of 5X SSC at 42 °C to SEQ ID NO:45, and have one or more specified biological properties. Thus, as in Example 9 of the Guidelines, the claims of the instant application use both structure and function to define the claimed NF-ATc polypeptide. Based on the structural and functional limitations recited in the claims, a person of skill in the art would not expect substantial variation among the species encompassed within the claims and would recognize that the Applicants were in possession of the claimed invention at the time the application was filed. *See The Regents of the University of California v. Eli Lilly and Co.*, 119 F.3d 1559, 1566, 43 U.S.P.Q.2D 1398 (Fed. Cir. 1997), stating that “[a] description of a genus of cDNAs may be achieved by ... a recitation of structural features common to the members of the genus, which features constitute a substantial portion of the genus.”

Rejections Under 35 U.S.C. §112, ¶2

The Examiner rejects claims 1-21 as indefinite for various reasons. Applicants respectfully submit that the claim amendments overcome all of the Examiner’s indefiniteness rejections.

Rejection for Obviousness-Type Double Patenting

The Examiner has rejected claims 1-21 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent Nos. 6,352,830 and 6,171,781 to Crabtree et al. Without conceding the appropriateness of these rejections, Applicants will submit a terminal disclaimer, if necessary, to obviate these rejections upon indication of allowable subject matter.

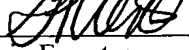
Conclusion

In view of the foregoing amendments and remarks, Applicants submit that the pending claims are in condition for allowance. Early and favorable reconsideration is respectfully solicited.

Applicant believes no fee is due with this response. However, if any fee is due, please charge our Deposit Account No. 18-1945, under Order No. SUPP-P05-008 from which the undersigned is authorized to draw.

Dated: January 28, 2004

Respectfully submitted,

By 
Gloria Fuentes

Registration No.: 47,580
ROPES & GRAY LLP
45 Rockefeller Plaza
New York, New York 10111-0087
(212) 841-5700
(212) 841-5725 (Fax)
Attorneys/Agents For Applicant